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10/037,134

01/04/2002

Gregory Butcher

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EXAMINER

HARBECK, TIMOTHY M

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/037,134

Applicant(s)

BUTCHER, GREGORY

Examiner

Timothy M. Harbeck

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 31-32 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

A proper dependent claim shall not conceivably be infringed by anything which would not also infringe the basic claim. See MPEP § 608.01(n), Section III. However, the depending claims 31-32 recite "A publication that lists recommended companies derived by a method according to claim 14." and "A computer program product that lists recommended companies derived by a method according to claim 14" and "A financial service center according to claim 24, wherein the check includes an offer of free assets, credited to a newly established account created by the recipient of the check." Applying the infringement test, what is needed to infringe claims 31 is, for example, a publication that lists recommended companies. However, such a publication would not infringe the method steps of claim 14 since the publication itself never performs any of the active steps of analyzing and assessing required by the method. In other words, mere possession of such a publication would infringe claims 31, but this is not enough to infringe claim 14. As a result, claim 31 is an improper dependent claim. The same logic holds for claim 32.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Independent claims 1 and 13 call for an analysis of geographic data of shareholders to provide an indication of an investment opportunity. However in the specification it is stated that the threshold levels from which to determine the level of significance of this data are established by "routine trial and error," and further that the results of these trials "may vary from one line of business to another and it may also vary from one country or region to another." Finally it is concluded that "in some circumstances, a threshold value level of 20% above average may be significant, while in other cases, a value of 500% or more may be required to indicate a significant cluster. However it is likely that values between these, or even outside of this range, will be more appropriate." (Page 10 lines 1-7) From these statements there is simply no way a person of ordinary skill in the art could determine a) the appropriate threshold level for a particular business entity (how much trial and error) and b) the level of significance that this threshold level reveals. The specification states in essence that results may vary, but provides no way to determine how the assessment can be adjusted in light of this. Therefore these claims lack the enablement requirement.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are directed toward a system, however there are no structural limitations in the claims that provide for the composition of the system. A proper system claim must list the structural components of which the system is comprised.

Claim Rejections - 35 USC § 101

Claims 1-13 and 32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are directed toward a system, however there are no structural limitations in the claims that provide for the composition of the system. These claims appear to be directed toward software.

Software, programming, instructions or code not claimed as encoded on computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in a computer. When such descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases.

Furthermore, software, programming, instructions or code not claimed as being computer executable are not statutory because they are not capable of causing functional change in a computer. In contrast, when a claimed computer-

readable medium encoded with a computer program defines structural and functional interrelationships between the computer and the program, and the computer is capable of executing the program, allowing the program's functionality to be realized, the program will be statutory.

Claims 1-13 and 32 are therefore rejected where there is no indication that the proposed software is recorded on computer-readable medium and/or capable of execution by a computer. Examiner suggests that the applicant incorporate into Claims 1-13 and 32 language that the proposed software is recorded on computer-readable medium and capable of execution by a computer to overcome this rejection.

Correction required. See MPEP § 2106 [R-2].

Claims 14-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); *In re Ziegler*, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

The second factor in this test for practical application is a determination of whether the claimed invention produces a concrete result. Usually, this question arises when a result cannot be assured. In other words, the process must have a result that

can be substantially repeated. Note that the focus is on the result, not the steps themselves. Concrete data processing steps could still produce an unrepeatable result if the data being processed is subjective. However, the mere fact that the result is an estimate, prediction or other approximation that may not ultimately be found to be accurate is not a determinative factor for concreteness. Thus, an assured result refers to repeatability and ability to achieve a result rather than ultimate accuracy of the result.

In the immediate instance the claimed assessment of the investment opportunity based on geographical analysis is based on "routine trial and error" (Page 10, line 1). Furthermore the level of significance that is attached to these values appears to be a subjective decision (is 20% significant? Is 500% significant ect.). In other words the ultimate decision to be made, whether the company in question represents a good business opportunity, could be different based upon the preference of the user. Because the claims do not guarantee a concrete result, they are directed toward non-statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segal et al (US 2002/0133449 A1) in view of Rasco (Michelle Mae Rasco, PhD. "Social

Network Analysis for use in change of venue cases.” Baylor University, 1998 63 pages; AAT 9834132).

Re Claim 1: Segal discloses an assessment system for assessing a company comprising:

- A geographical location stage operative to derive geographical data representative of the geographical location of one or more shareholders of the company (paragraph 0026; “profiles of shareholders, shareholders by census region.”)

Segal does not explicitly disclose

- An analysis stage operative to analyze the geographical data to provide an indication of the investment potential of shares of the company.

Rasco discloses a network analysis study that shows how interactions between a community of individuals can be studied which allows for influence within a community to be traced (See abstract). Essentially what Rasco shows is how a community reacts to a local company and more specifically how a certain opinion can propagate throughout a community. While not explicitly disclosing wherein said analysis provides an indication of the investment potential of the company, this step would have been obvious to a person of ordinary skill in the art at the time of invention. One would be motivated to do so in order to gauge the opinion of the persons with the most intimate knowledge of the company and/or opportunity to invest. People in close proximity to a particular situation often have a keen understanding of the potential or prospects of a company and their decision to invest or not can be a telling sign.

Re Claim 2: Segal in view of Rasco discloses the claimed system supra and Segal further discloses wherein the geographical location stage is further operative to determine the geographical location of one or more persons connected with the company (paragraph 0026; “profiles of shareholders.”)

Re Claim 3: Segal in view of Rasco discloses the claimed system supra but does not explicitly disclose wherein the each person is a director of the company. However it official notice is taken that this was notoriously well known in art at the time of invention for the director of a company to also be a shareholder of said company. Therefore it would have been obvious to a person of ordinary skill in the art at the time of invention to include this step to Segal in view of Rasco in order to determine the profiles of the executives. Furthermore it is well known that this information is available on many websites, such as CNN.com, under the “Insider Dealings” header of the financial quote for the company.

Re Claim 4: Segal in view of Rasco discloses the claimed system supra but does not explicitly disclose wherein the analysis stage is operative to analyze geographical location of one or more shareholders in relation to the geographical location of one or more persons connected with the company. However Official Notice is taken that this step is old and well known in the art. Information about shareholders and persons affiliated with a company is readily available for analysis and is public information. Therefore it would have been obvious to a person of ordinary skill in the art to include this step for investors or potential investors to utilize as much information as

possible in order to analyze and correlate data variables when searching for investment opportunities.

Re Claims 5 and 6: Segal in view of Rasco discloses the claimed system supra but does not explicitly disclose wherein the geographical location stage comprises a database in which an address can be looked up in order to determine the geographical location of the address and wherein the database comprises a database of geographical postal codes. However Official Notice is taken that it was notoriously well known in the art at the time of invention to utilize an online search engine or database to locate the geographical region of an address or postal code. Websites such as mapquest.com or even weather.com allow a user to enter this information in order to lookup the geographical location. It would have been obvious to a person of ordinary skill in the art at the time of invention to include this step in order to quickly and easily determine the general location of an address or postal code so that further correlation with other data (shareholders) can be performed.

Re Claim 7: Segal in view of Rasco discloses the claimed system supra but does not explicitly disclose wherein the database includes a specification of the geographical location of a postal code to a degree of accuracy that is of the same order as a street address. However official notice is taken that this step is old and well known in the art. Websites such as mapquest.com allow a user to enter this information in order to lookup the geographical location. The more specific the information, the more accurate the result. It would have been obvious to a person of ordinary skill in the art at the time of invention to include this step in order to quickly, easily, and precisely

determine the general location of an address or postal code so that further correlation with other data (shareholders) can be performed.

Re Claim 8: Segal in view of Rasco discloses the claimed system supra but does not explicitly disclose wherein the operative to analyze the family relationships that might exist between shareholders and directors and employees of a company.

However Official Notice is taken that this step is old and well known in the art.

Analyzing family relationships with respect to stock purchases and sales has been known for years, specifically as a way to identify potential violations of insider trading.

Providing inside information for the purposes of investment to others is a violation of the law. A large purchase or sale of stock by a relative or a closely related acquaintance is often a sign of this. It would have been obvious to a person of ordinary skill in the art at the time of invention to include this step because it provides insight into the potential of the stock or company. A close relative purchasing a large amount of stock indicates that this company has good prospects, while the opposite is true of a large sell off.

Re Claim 9: Segal in view of Rasco discloses the claimed system supra and Segal further discloses a display stage that is capable of producing a display that is representative of data produced by the geographical location stage and/or analysis stage (paragraph 0009)

Re Claim 10: Segal in view of Rasco discloses the claimed system supra and Segal further discloses wherein the display stage produces the display in combination with a display of a geographical map (0009-0010; map of the exchange area, generates

alphanumeric images of selected data.... and maps these images onto surfaces of perspective views.)

Re Claim 11: Segal in view of Rasco discloses the claimed system supra and Segal further discloses wherein items within the display are produced to have a visual appearance that is representative of qualitative properties of the data (paragraphs 0009-0010).

Re Claim 12: Segal in view of Rasco discloses the claimed system supra and Rasco further discloses wherein the analysis stage is operative to base its analysis only on shareholders that are natural persons (see abstract; analysis studies of interactions between individuals.)

Re Claim 13: Segal in view of Rasco discloses the claimed system supra and Segal further discloses wherein the system is constituted in software executing on suitable computer hardware (Fig 1).

Re Claims 14-23: Further method claims would have been obvious to perform from the previously rejected system claims 1-6 and 8-11 respectively and are therefore rejected using the same art and rationale.

Re Claim 24 and 25: Segal in view of Rasco discloses the claimed system supra but does not explicitly disclose the step wherein the geographical analysis excludes from consideration predetermined classes of shareholders and wherein said analysis excludes corporate and nominee shareholder. However official notice is taken that the exclusion of variables in an analysis is an old and well known in the art. It would have been obvious to a person of ordinary skill to include these steps to the

disclosure of Segal in view of Rasco in order to further refine the analysis to particular subgroups or classes of shareholders.

Re Claim 27: Segal in view of Rasco discloses the claimed method supra but does not explicitly disclose the step of considering the results of the geographical analysis to provide a list of companies for investment. However official notice is taken that any investment analysis is undertaken with the desire to produce a list of companies that fit a particular investment profile. It would have been obvious to a person of ordinary skill in the art at the time of invention in order to utilize the analysis for the practical purpose of determining investment alternatives.

Re Claim 28: Segal in view of Rasco discloses the claimed method supra but does not disclose the step in which consideration of the geographical results includes identification geographical of clusters of shareholders of a company in the region of an office of the company or of its advisors, being one or more of its accountants, PR agents, brokers or market makers in shares. However Rasco shows how interactions between a community of individuals can be studied which allows for influence within a community to be traced (See abstract). Essentially what Rasco shows is how a community reacts to a local company and more specifically how a certain opinion can propagate throughout a community. While not explicitly disclosing this influence in terms of location of shareholders versus executives of a company, Official Notice is taken that this step would have been obvious to a person of ordinary skill in the art. One would be motivated to do so in order to gauge the opinion of the persons with the most intimate knowledge of the company and/or opportunity to invest. People in close

proximity to a particular situation often have a keen understanding of the potential or prospects of a company and their decision to invest or not can be a telling sign.

Re Claim 29: Segal in view of Rasco discloses the claimed method supra but does not explicitly disclose the step in which a cluster is identified where a geographical area has a number of shareholders in a given area more than a threshold above an average expected value for that area. However Official Notice is taken that the step of identifying a success or failure of a particular group in an analysis by comparing it to a control group is notoriously old and well known in the art. It would have been obvious to a person of ordinary skill to include this step in order to interpret the results from the data being analyzed.

Re Claim 30: Segal in view of Rasco discloses the claimed method supra but does not explicitly disclose the step in which a cluster is identified where a geographical area has a number of employee shareholders in a given area more than a threshold above an average expected value for that area. However Official Notice is taken that the step of identifying a success or failure of a particular group in an analysis by comparing it to a control group is notoriously old and well known in the art. It would have been obvious to a person of ordinary skill to include this step in order to interpret the results from the data being analyzed.

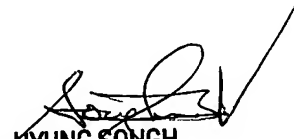
Re Claims 31-33: Further publication, computer software product and display system would have been obvious in order to implement the previously rejected method claim 14 and are therefore rejected using the same art and rationale.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Harbeck whose telephone number is 571-272-8123. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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